

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the July 24, 2008 Office Action. In response, applicant has amended claims 1, 12-14, 20, 21 and 25; and canceled claims 5, 15, 26 and 28-31. In light of these amendments, and the following remarks, applicant respectfully requests reconsideration and reexamination of the application.

TIME EXTENSION REQUEST

Applicant submits herewith a one-month time extension request, with pertinent fee.

CLAIM REJECTIONS

All of the pending claims were rejected in the Office Action as being unpatentable under 35 U.S.C. §103(a) as being obvious in light of various references, and combination of references. As indicated in the title of the application, and the preamble of each independent claim, the present invention is directed to a method of manufacturing an animal chew toy. As stated in the M.P.E.P., the claim preamble is necessary to give life, meaning and vitality to the claim in which the claim preamble should be construed as if in the balance of the claim, see M.P.E.P. 2111.02. As such, the field of endeavor or prior art which should be considered should be in the animal chew toy fields, not in unrelated fields.

Eleven different references have been used in rejecting the various claims of the application. The eleven references are:

Boyer et al. (U.S. Patent No. 2,943,969), a method of manufacturing a repair patch;

Wallace (U.S. Patent No. 2,782,830), directed to a pneumatic tire;

Riehl (U.S. Patent No. 3,062,696), directed to pneumatic tires;

Eby et al. (U.S. Patent No. 3,728,749), directed to a tire float and method for forming same;

Ogura (U.S. Patent No. 4,098,214), directed to a float made of an automobile tire;

Spross (U.S. Patent No. 1,596,071), directed to a swing made up of discarded automobile tires;

Kraus (U.S. Patent No. 2,984,281), directed to a process of bonding of elastomers;

Oswald (U.S. Patent No. 4,830,781), directed to a body reinforcing component and apparatus and method for the same for reinforcing a tire body underlying the tread and the sidewall regions of the tire;

Hartnett et al. (U.S. Publication No. US 2002/0111412 A1), directed to molded objects;

Kahnweiler (U.S. Patent No. 1,534,964), directed to an animal toy; and

Sonnett et al. (U.S. Patent No. 2,495,079), directed to inflatable game balls and improvements in securing the edges of cover sections to the carcass of balls of the same.

Applicant notes that of the eleven cited references, only one of the references is directed to an animal chew toy. None of the other references are directed to an animal chew toy in the slightest. As stated by M.P.E.P. §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Citing, *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 218 USPQ 698 (Fed. Cir. 1983). Further, a prior art reference must be considered in its entirety, i.e., as a whole including portions that would lead away from the claimed invention. M.P.E.P. §2141.02, citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied*, 469 US 851 (1984). The claimed invention must be viewed as a whole. *Bausch & Lomb, Inc.*, 796 F.2d at 449 [230 USPQ at 420] (citing

Jones v. Hardy, 727 F.2d 1524, 1527-1528, 220 USPQ 1021, 1023-1024 (Fed. Cir. 1984). The proper test in analyzing the prior art is whether the prior art reference, taken as a whole, would have suggested the invention to an ordinary person skilled in the art. *Jones*, 727 F.2d at 1530, 220 USPQ at 1026.

In determining the obviousness of an invention, it is impermissible to pick and choose from any one reference only so much of it as will support a given position while excluding other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc.*, 796 F.2d at 448 [230 USPQ at 419-420] (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

Applicant respectfully submits that the Examiner has not considered the references as a whole, nor the invention as a whole, and that the rejections based upon the non-analogous teachings of these references is improper. Moreover, applicant submits that teachings of the above-identified references have been picked and chosen only so much as it would support a given position, while excluding the other parts necessary to the full appreciation of what the references fairly suggest to one skilled in the art. Thus, applicant respectfully submits that the rejections should be withdrawn.

With regard to the specific rejections, claims 1, 5, 14, 16, 28 and 29 were rejected under 35 U.S.C. §103(a) as being obvious over Boyer. The Office Action states that "Boyer teaches a method for manufacturing an article which could be used as an animal chew toy". Moreover, the Office Action states that "the article of Boyer is a disk (Figures), which could be flown." Applicant respectfully disagrees with these assertions.

Boyer is directed to a method of manufacturing a repair patch for rubber articles such as tires, tubes, rubber balls, bags and the like (see column 1, lines 15-18). As disclosed in column 2 of Boyer, a sandwich strip 14 of rubber strips 12 and 13 and a reinforcing material 11 is cut into approximately 3/4 of an inch patch pieces or sandwich squares. The sandwich squares are then formed into a generally round patch form, as illustrated in Fig. 4. The resulting patch can only be an inch or two in diameter. There is

no teaching, suggestion, or even inference in Boyer that the repair patch be used whatsoever as an animal chew toy. In fact, such a patch being only approximately an inch or two in diameter would not be used as an animal chew toy, but instead could actually present a choking hazard to the animal as the repair patch would be sufficiently small so as to be swallowed.

Moreover, Boyer fails to teach all of the claim limitations of independent claims 1 and 14. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)).

Accordingly, applicant respectfully submits that independent claims 1 and 14 are patentably distinct, and not rendered obvious, by the Boyer reference. Accordingly, those claims depending therefrom (3, 7-13, 16-20 and 27) are also non-obvious, as if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent claim 21 was rejected under 35 U.S.C. §103(a) as being obvious over Boyer in view of Kraus. The Office Action admitted that Boyer does not specifically teach cutting of the fiber mesh or rubber. Moreover, Boyer only teaches one mold. Furthermore, the Office Action correctly states that Boyer is silent with respect to carbon black in the rubber. Furthermore, the Office Action correctly states that Boyer provides an article meant to be used to repair tires. The rejection is based upon the assertion that since Kraus teaches that it is known to incorporate carbon black in the material, it would have been obvious to incorporate the carbon black to provide a tire patch matching the tire.

Applicant respectfully asserts that the Kraus reference fails to overcome the shortcomings of the Boyer reference, as indicated above. Moreover, Kraus and Boyer fail to disclose all of the recitations in independent claim 21. Thus, this rejection should

be withdrawn as well, and those claims depending from independent claim 21 deemed non-obvious in light of the Boyer and Kraus references.

Claims 1, 3, 5, 9, 10, 12, 13, 26 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kraus in view of Oswald.

On page 4, it is admitted in the Office Action that Kraus does not specifically teach the use of a floss material comprising a mesh molded between the two sheets of rubber material. It was asserted in the Office Action that Oswald teaches that it is conventional to mold a fiber mesh material between two sheets in a tire. However, applicant respectfully asserts that the methodology used by Oswald is significantly different than the methodology of the present invention.

Oswald teaches of the use of an individual continuous cord strand which is interleaved and woven onto a base and sidewall 16, followed by the application of the tread portion of the tire. Oswald teaches of a substantially zig-zag pattern for the cord lengths forming a tread section 18 underlying the tread, while having cord length that lies substantially parallel to each other in the sidewall region 20. A number of coated continuous cord lengths 26 are disposed in zig-zag repeating pattern with succeeding lengths of the strips being displaced from each other. The cord lengths are interleaved with lengths of cord disposed at an opposite angle along at least one line substantially parallel to and intermediate the sides of tread section. This interleaving relationship results in a woven structure. (See column 4, lines 30-50). As described in column 4, lines 62-66, the individual continuous cord reinforcement strands are embedded in or coated with a suitable rubber or other polymeric material. With reference to FIGS. 1, 4A and 4B, Oswald teaches that the weaving of tire reinforcing belts is known in the art by moving weaving heads supplying cord to the surface in timed relationship to the movement of the surface. As further stated in column 5, the weaving of the individual cords is performed on the underlying carcass or sidewalls of the tire, as the tire is created.

It will be appreciated by those skilled in the art that the complicated weaving pattern, necessary weaving heads, etc. to create the desired pattern of Oswald onto an

underlying tire carcass, before the tread is applied thereto, is significantly more complicated and expensive than the methodology of the present invention. The methodology of the present invention does not require moving weaving heads supplying rubber coated cords into a complicated weaving pattern having a zig-zag configuration and generally spaced apart in parallel relationship along sidewalls of the tire carcass during formation of the tire. Instead, in accordance with claim 1, first and second layers of rubber material are already formed in a general shape and size of the animal chew toy. A sheet of synthetic fibers is also formed in a general shape and size of the animal chew toy, and placed between the first and second layers of rubber material. These layers are then compress molded under pressure and heat into the animal chew toy. Such a complicated and expensive weaving head arrangement is not required by the present invention, and a combination of Kraus and Oswald fail to render independent claim 1 obvious.

The independent claims specify that the first and second layers of rubber material are cut into a general shape or size of the animal chew toy. A floss material comprising a synthetic fiber mesh which is cut into the general shape or size of the animal chew toy is placed between the first and second layers of rubber material, and they are compressed under pressure and heat to mold the animal chew toy. Once again, the combination of Kraus and Oswald fail to disclose pre-cut sheets of rubber material and fiber mesh material which are layered and subsequently molded.

Accordingly, applicant respectfully submits that independent claim 1, and those claims depending therefrom, are patentably distinct from the combination of Kraus and Oswald. Kraus and Oswald fail to teach or suggest all of the claim limitations of independent claim 1, and a *prima facie* case of obviousness has not been established.

For instance, in independent claim 1, first and second layers of rubber material are cut into a general shape and size of the animal chew toy. The rubber material layers, as well as the cut floss material in the general shape and size of the animal chew toy, is molded into the animal chew toy. However, both Kraus and Oswald teach of adhering sections, such as an outer section having a tire tread already formed

thereon, to one another. Neither of these references teach of molding first and second layers of rubber material having at least one mesh fabric sheet of synthetic fibers by compressing the sheets of rubber and floss material between opposing mold members under pressure and heat to form an animal chew toy. Moreover, while Kraus and Oswald are directed to tires, and thus have a tire configuration, they do not disclose a flying disc, a bone, or an elongated cylindrical retriever configuration.

With respect to claim 12, this claim has been amended to more specifically recite the step of adding a rubber masking scent material to the first and second layers of rubber. While Kraus may have an inherent scent, that inherent scent is the rubber material scent which the present invention intends to mask by adding an additional scent material.

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kraus, in view of Oswald, and further in view of Spross (U.S. Patent No. 1,596,071). It was admitted that Kraus and Oswald are silent with respect to a rope. Applicant respectfully submits that this is due to the fact that Kraus and Oswald are directed to the creation of tires to be used in association with vehicles or the like, and that it would not make any sense whatsoever to associate a rope therewith.

Spross is directed to the creation of a tire swing for people, and in particular children. Spross teaches the binding of several tires to one another and hanging this tied tire arrangement from an elevated position so as to create a swing. Applicant respectfully submits that one of ordinary skill in the field of animal chew toys would not look to Spross. The Spross reference is completely non-analogous to the present invention, and is also non-analogous to Kraus and Oswald. In the present invention, the purpose of the attached rope is to provide a handle-hold for the user to hold the animal chew toy while the animal chews thereon, in a playful manner, or even to throw the animal chew toy. Such is not the case with Spross, which uses the rope to interconnect multiple tires to one another and hang this tire arrangement from a tree limb, beam or the like to create a swing.

Obviousness cannot be established by combining the teachings of prior art references to produce the claimed invention absent some teaching or suggestion supporting the combination. The teachings from different references can be combined to invalidate a patent only if there is some teaching or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 932-933 (Fed. Cir. 1984).

It is improper to use the patent in suit as a guide through a maze of prior art references, combining the right references in the right way so as to achieve the results of the claims sought to be invalidated. *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199-200 (Fed. Cir. 1983). Applicant respectfully submits that the Examiner has used the patent application as a guide through a maze of prior art to combine otherwise non-analogous references and to read similarities between those references to the present invention without taking these references as a whole, including those portions which teach away from the invention and would lead away from obviousness.

Claims 9-11 were rejected under the combination of Kraus in view of Oswald, and further in view of Eby (U.S. Patent No. 3,728,749) or Ogura (U.S. Patent No. 4,098,214). Both Eby and Ogura disclose a float made of an automobile tire. Eby discloses that used tire bodies can be converted into marine floats for use as moorings, buoys or the like. Similarly, Ogura teaches of converting tires into float devices used to keep afloat a mooring, lighted or other buoys intended to aid in navigation, rafts, shellfish planting or the like.

Once again, these references are completely non-analogous to the present invention. While they may disclose inserting buoyant material into an automobile tire, the purpose is completely different than the present invention. In the present invention, the purpose of the buoyant material is so that the toy can be thrown into water, float, and be easily retrieved by the dog or other animal. In the cited Eby and Ogura patents, the purposes are completely different than that of the present invention, and there is no discussion whatsoever of the creation of an animal chew toy.

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kraus in view of Oswald and further in view of Hartnett. While Hartnett teaches that it is known to provide an odor-masking agent, such as vanilla extract, to a mixture to be molded and vulcanized, there is absolutely no motivation or suggestion to combine Hartnett with either Kraus or Oswald. In fact, there is no conceivable purpose for doing so as there is no benefit to a vehicle tire, or even a tire for a bicycle or the like, which has an odor-masking scent added thereto. However, in the present invention, there is a clear and definable purpose for doing so as it makes the animal chew toy more appealing to the animal to have the odor-masking scent, as opposed to the harsh rubber (in most cases a tire rubber) scent. This teaching or suggestion is clearly not present in these references, and thus due to lack of motivation, the rejection must fail, and should be withdrawn.

Claims 14-16, 20, 21, 25, 27, and 29-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kraus in view of Riehl and Wallace. It was admitted in the Office Action that Kraus does not teach the use of a floss material comprising a mesh molded between two sheets of cut tire rubber material. In the Office Action, it was stated that "However, Riehl teaches that it is known to provide a tread portion which is cut and spliced (6:71-73). Wallace teaches that it is known to provide a bias-cut reinforcing material between layers in a tire (2:28-53)." It was further asserted that "It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Riehl and Wallace into that of Kraus because (a) Kraus teaches or suggests a tread portion, and Riehl provides a conventional for manufacturing and assembling the tread, and (b) reinforcement material would have obviously been desirable and applicable in the Kraus process since it would help prolong tire lifetime and reduce blowouts."

Riehl is particularly concerned with a process for treating treads of tires (see column 1). Riehl discloses the problem of groove cracking, or opening of small fishers within the depressed tread area of the road-contacting portion of a tire. Thus, Riehl

coats a portion of a freshly prepared tire tread which corresponds to the ultimate road-contacting area of the tire with an elastomeric composition.

Applicant fails to see how Riehl applies whatsoever to the present invention. The present invention, as recited in the claims, does not disclose a process for applying an elastomeric composition onto a tread of the tire configuration of the animal chew toy for any purposes whatsoever. Clearly, the animal chew toy is going to be chewed and damaged and destroyed by the dog. Thus, it is not important whatsoever if there are cracks or fishers in the grooves of the tire tread. Moreover, applicant fails to see how Riehl provides any missing teaching of Kraus, as indicated above.

In column 2, lines 28-54, Wallace discloses many steps, which are fairly complex, in creating the pneumatic tire of Wallace. Moreover, Wallace discloses that its tire have bead assemblies, including rubber covered wires wrapped in strips of rubberized fabric.

Clearly, the present invention, as being directed to an animal chew toy, does not contain metal, and in fact the claims specify that there is no metal therein. Obviously, this could damage the gums and mouth of the animal chewing on the toy. Furthermore, Wallace does not provide the missing teachings of Kraus, but instead provides a very complex methodology of creating a pneumatic tire, such as those as would be used on vehicles. It is highly doubtful that such tires would be used in simple children's toys. Moreover, Wallace is not directed whatsoever to an animal chew toy, nor is Kraus. Thus, the teachings of these references (which teach away from one another) have been combined in order to reject the claims of the present invention, which is directed to an animal chew toy. The fact that Wallace teaches that it is known to provide a bias-cut reinforcing material between layers in a tire is of no consequence to the present invention as Wallace actually teaches that portions of the tire are already pre-made, such as the tread portion, etc. that are not bias-cut, and do not constitute reinforcing material. In fact, in the present invention, there is no such bias-cut reinforcing material recited in any of the claims. Thus, applicant fails to see how the combination of these references renders the claims obvious.

Of course, if the combination of Kraus, Riehl and/or Wallace are incapable of rendering independent claims 14 and 21 obvious, they cannot, either alone or in combination with the additional references, render the dependent claims obvious. Applicant further refers to the arguments above with respect to these various references, including the Spross reference, Eby, Ogura, and Hartnett.

Claims 1, 8, 9, 14, 18, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kahnweiler in view of Sonnett.

Kahnweiler is directed to an animal toy in the form of a hollow rubber ball having an artificial mouse therein. It is taught that the ball can be made from rubber, but also can be made from other materials such as metal, fiber or the like. However, these other materials are indicated as not desirable as they would not have the resiliency to permit the artificial mouse to be fit through an expanded aperture and into the ball, such that the artificial mouse cannot be retrieved or fall out of the aperture later.

As admitted in the Office Action, Kahnweiler is silent with respect to the steps of providing two sheets of rubber with a floss material therebetween. Nor is there any discussion whatsoever of molding these under compression and pressure and heat to form an animal chew toy.

Thus, the animal toy of Kahnweiler was combined with the Sonnett et al. inflatable game ball patent in an attempt to reject the claims.

Clearly, the teachings of Kahnweiler and Sonnett are only analogous to one another given the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. v. Clonetech Laboratories, Inc.*, 56 USPQ 2d 1186 (Fed. Cir. 2000).

The Examiner picks and chooses aspects of the references in light of Applicant's claims in attempting to reconstruct Applicant's invention. The Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention.

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

Uniroyal Inc. vs. Rudkin-Wiley Corp. 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

Ecolochem Inc. v. Southern California Edison, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffett*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

Applicant respectfully asserts that there is no teaching, suggestion, or motivation to combine the references, as proposed by the Examiner, absent the teachings of the present invention. The showing of combinability is not clear and particular whatsoever. The prior art references do not provide the suggestion or motivation to make the combination. Instead, improper hindsight reasoning has been used.

Sonnett is particularly directed to improvements in securing the edges of cover sections to the carcass of inflatable game balls (such as basketballs, footballs, and volleyballs) and to a seam formed by the cover sections and the ball carcass. Clearly, the hollow rubber ball of Kahnweiler is not directed to these concerns whatsoever. In fact, in the illustrations of Kahnweiler, there are no edges, seams, or cover sections of the carcass of the ball.

Moreover, as the animal toy of Kahnweiler is directed to a toy to be played with by a cat, such that the cat bats and chases the rolling ball on the floor in an attempt to get the artificial mouse inside, there is no teaching, and no need for any teaching, of providing a multi-layer material consisting of two layers of rubber material having a floss material disposed therebetween.

Furthermore, Kahnweiler and Sonnett fail to disclose all of the limitations of independent claims 1 and 14.

From the foregoing, applicant respectfully submits that the Kahnweiler and Sonnett references have been improperly combined and improperly used in rejecting the claims. There is no motivation to make the combination as proposed by the Examiner absent the teachings of the present invention. Furthermore, these references fail to disclose all the claim recitations of the claims rejected, and thus the rejection must fail and should be withdrawn.

With respect to claims 9 and 19, it was asserted that the artificial mouse of Kahnweiler is buoyant. However, there is no such teaching or suggestion to that effect, as the mere fact that the artificial mouse is preferably formed of cloth and can be filled or stuffed with catnip does not necessarily make it buoyant, and most certainly would not make the ball itself buoyant. Furthermore, there would be no purpose in making the ball buoyant as a cat would not chase and play with a ball in water.

With respect to claims 12 and 20, there is no motivation in the references themselves to be combined as has been proposed by the Examiner. The mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the

modification. *In re Fritch*, 23 USPQ 2d 1780 (Fed. Cir. 1992). Applicant believes that impermissible hindsight was used in reconstructing references in an attempt to reject the claims of the present application.

From the foregoing, applicant respectfully submits that the currently pending claims, as amended, are patentably distinct from the references, as indicated above. Thus, these claims are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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